

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
)	
Shinichi HASEGAWA et al.)	Group Art Unit: 3663
)	
Application No.: 10/822,072)	Examiner: Tuan C. To
)	
Filed: April 8, 2004)	
)	
For: ONBOARD APPARATUS,)	Confirmation No.: 2104
NAVIGATION SYSTEM, AND)	
METHOD FOR SETTING DISPLAY)	
SCREEN)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER BOARD RULE § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer mailed January 21, 2010, which has a two-month period for reply extending through March 22, 2010 (March 21, 2010 being a Sunday). This Reply Brief addresses the new points in the "Response to Argument" section of the Examiner's Answer.

If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account 06-0916.

I. **RESPONSE TO EXAMINER'S ARGUMENTS IN THE ANSWER**

A. **The Board Should Reverse the Rejection of Claims 1 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Carroll* and *Lightner***

The Examiner's rejection of claims 1 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Carroll* and *Lightner* should be reversed. Appellants submit that a *prima facie* case of obviousness has not been established for reasons of record and for the additional reasons set forth below.

Independent claim 1 recites an apparatus mounted on a vehicle including, for example, "automatically getting vehicle model information from the vehicle **by determining a shape** of a connector used to attach the onboard apparatus to the vehicle . . ." (emphasis added). Therefore, the claim very distinctly requires that the vehicle model information be determined according to the **shape** of the connector. The Examiner continues to rely on *Lightner* in the Examiner's Answer as allegedly disclosing this claimed feature, and Appellants continue to respectfully disagree.

As discussed on page 11 of the Appeal Brief, *Lightner* utilizes a **standardized** OBD-II connector, having "a serial, 16-cavity layout, with specific electrical connections in separate cavities supplying data and electrical power from the OBD/EDU system 100." *Lightner*, col. 6, ll. 60-62. Appellants stress the fact that this connector is standardized, and that "[a]ll **physical and electrical characteristics** of this connector are **standard for all vehicles** sold in the United States after 1996." *Lightner*, col. 1, ll. 51-53 (emphases added). Accordingly, based purely on the fact that the OBD-II connector in *Lightner* has a physical characteristic, or shape, standard to all vehicles, it would be impossible to determine vehicle information based on the shape of this

standard connector, and therefore *Lightner* simply cannot teach or suggest "getting vehicle model information from the vehicle **by determining a shape** of a connector," as recited in independent claim 1 (emphasis added).

The Examiner alleges in the Response to Argument section of the Examiner's Answer that, "[i]t is important to note that [in *Lightner*] the shape of the connector (120) is defined by its format and the specific formed position of the cavities from the 16 cavity layout rather than the standard shape of the OBD-II with 16 cavity layout." *Examiner's Answer* at 10. Appellants strongly disagree with this characterization of *Lightner*, and respectfully assert that the Examiner has misrepresented *Lightner*. *Lightner* uses the OBD-II connector which, as noted above, is **standard for all vehicles** sold in the United States. See *Lightner*, col. 1, ll. 51-53. Therefore, the Examiner's allegation that the shape of the connector is defined by its format is clearly false, as such a reading of *Lightner* contradicts what is explicitly disclosed in *Lightner*. The shape of the OBD-II connector in *Lightner* is standard and does not change; accordingly, it is impossible to determine model vehicle information based purely on the **shape** of the connector, since the connector in *Lightner* is always a standard shape.

The OBD-II connector used in *Lightner* does not have a shape defined by its format, as alleged by the Examiner, rather, the connector **always has a serial, 16-cavity layout**, and the characteristics of the connector are **standard for all vehicles**, as noted above. See *Lightner*, col. 1, ll. 51-53, and col. 6, ll. 60-62. The Examiner provides absolutely zero support for the allegation that "the shape of the connector (120) is defined by its format and the specific formed position of the cavities from the 16 cavity layout rather than the standard shape of the OBD-II with 16 cavity

layout,” as the Examiner alleges on page 10 of the Examiner’s Answer. Such statements without support from any disclosure of *Lightner* are clearly improper. Indeed, such an allegation contradicts the fact that *Lightner* explicitly discloses that the connector is **standard for all vehicles** sold in the United States, as noted above, and therefore all vehicles have a standard shaped connector.

Indeed, the only thing that changes in *Lightner* is the data format provided through the standardized connector, and which of the 16 cavities are used to transmit the data. “[D]ata transmitted through [the connector] may have a format and pass through cavities **that depend on the vehicle’s make and model.**” *Lightner*, col. 6, l. 66 - col. 7, l. 1 (emphasis added). The standardized connector always has 16 cavities, and different vehicle manufacturers use particular data formats and specific cavities out of these always-present 16 cavities depending on the type of vehicle. See *Lightner*, col. 6, l. 60 - col. 7, l. 7.

Ultimately, no determination is made in *Lightner* as to the vehicle model information based on the shape of the connector, as required in independent claim 1. Indeed, it is impossible for any such determination in *Lightner*, due to the fact that *Lightner* discloses “[a]ll physical and electrical characteristics of [the OBD] connector are standard for all vehicles sold in the United States after 1996.” *Lightner*, col. 1, ll. 51-53. If such physical and electrical characteristics of the connector are standard, then a determination between vehicles based on the shape of such a standard connector is impossible.

For at least the reasons above, and for the reasons set forth in the Appeal Brief, combinations of *Carroll* and *Lightner* fail to establish a *prima facie* case of obvious with

respect to independent claim 1, and independent claim 1 is therefore allowable over the prior art of record. Claim 12 depends from independent claim 1, and is thus allowable for at least the same reasons as independent claim 1.

Therefore, a *prima facie* case of obviousness has not been established and Appellants respectfully request the Board to reverse the rejection of claims 1 and 12 under 35 U.S.C. § 103(a).

B. The Board Should Reverse the Rejection of Claims 14 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Carroll* and *Lightner*

The Examiner's rejection of claims 14 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Carroll* and *Lightner* should be reversed. Appellants submit that a *prima facie* case of obviousness has not been established for reasons of record and for the additional reasons set forth below.

Independent claim 14 recites an apparatus mounted on a vehicle, including, for example, "getting means for automatically getting vehicle model information from the vehicle by determining a formed position of the connector used to attach the onboard apparatus to the vehicle" Therefore, the claim very distinctly requires that the vehicle model information be determined according to a formed position of the connector. The Examiner continues to rely on *Lightner* in the Examiner's Answer as allegedly disclosing this claimed feature, and Appellants continue to respectfully disagree.

As discussed on page 13 of the Appeal Brief, and clearly established above with respect to independent claim 1, *Lightner* utilizes a **standardized** OBD-II connector, having "a serial, 16-cavity layout, with specific electrical connections in separate cavities

supplying data and electrical power from the OBD/EDU system 100." *Lightner*, col. 6,

II. 60-62. The Examiner alleges:

[t]he formed position of the connector (120) is defined by the formed position of the cavities from the 16-cavity layout. For instance, the numbers 2 and 10 stand for the formed position of the cavities in the format called J1850; the numbers 7 and 15 stand for the formed position of the cavities in the format called ISO 9141-2; and the numbers 6 and 14 stand for the formed position of the cavities in the format called J2284. This absolutely shows that processor (104) is provided for acquiring vehicle model information from the OBD/EDU system (100) via the connector (120) by determining the formed position of the cavities from the 16 cavity layout of the OBD-II connector.

Examiner's Answer at 10. Appellants respectfully disagree with the Examiner's allegations.

First, as noted above with respect to independent claim 1, the OBD-II connector used in *Lightner* is standardized, and always has a 16 cavity layout by which different cavities are used depending on the type of data format. See *Lightner*, col. 6, I. 60 - col. 7, I. 7. Contrary to the Examiner's allegations, no vehicle information is determined **based on the formed position of the connector**, as recited in independent claim 14, since the connector in *Lightner* will always be formed to have a 16 cavity layout, as such a connector is **standard to all vehicles** in the United States, as disclosed in col. 1, II. 51-53 of *Lightner*. Therefore, the Examiner's allegation that the passing of data through specific cavities in the OBD-II connector of *Lightner* is equivalent to "determining a formed position of the connector," as recited in independent claim 14, is clearly false, as such a reading of *Lightner* contradicts what is explicitly disclosed in *Lightner*.

The OBD-II connector used in *Lightner* does not deviate in any form, rather, the connector **always has a serial, 16-cavity layout**, and the characteristics of the connector are **standard for all vehicles**, as noted above. See *Lightner*, col. 6, l. 60 - col. 7, l. 7. The Examiner provides absolutely zero support for the allegation that "[t]he formed position of the connector (120) is defined by the formed position of the cavities from the 16-cavity layout," as the Examiner alleges on page 10 of the Examiner's Answer. Such statements without support from any disclosure of *Lightner* are clearly improper. Indeed, such an allegation contradicts the fact that *Lightner* explicitly discloses that the connector is **standard for all vehicles** sold in the United States, as noted above.

For at least the reasons above, and for the reasons set forth in the Appeal Brief, combinations of *Carroll* and *Lightner* fail to establish a *prima facie* case of obvious with respect to independent claim 14, and independent claim 14 is therefore allowable over the prior art of record. Claim 16 depends from independent claim 14, and is thus allowable for at least the same reasons as independent claim 14.

Therefore, a *prima facie* case of obviousness has not been established and Appellants respectfully request the Board to reverse the rejection of claims 14 and 16 under 35 U.S.C. § 103(a).

C. The Board Should Reverse the Rejection of Dependent Claims 2, 13, 15, and 17 under 35 U.S.C. §103(a)

For at least the reasons set forth in the Appeal Brief filed October 16, 2009, a *prima facie* case of obvious has not been established with respect to dependent claims

2, 13, 15, and 17. Accordingly, Appellants respectfully request the Board to reverse the rejection of claims 2, 13, 15, and 17 under 35 U.S.C. § 103(a).

II. **CONCLUSION**


The Examiner has failed to establish a *prima facie* case of obviousness at least because the Examiner has not properly ascertained the scope and content of the prior art. For the reasons set forth above, and in the previously submitted Appeal Brief, pending claims 1, 2, and 12-17 are allowable. Thus, Appellants respectfully request reversal of the Examiner's rejection.

Please charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 22, 2010

By: 
Trenton J. Roche
Reg. No. 61,164
direct: (202) 408-4268